

REMARKS

The following remarks are responsive to the Official Action mailed September 19, 2006.

In the Official Action, the Examiner request affirmation of the election of the invention of Species II drawn to claims 1-12 and 16-17. Thus, Applicants submit that during a telephone interview between the Examiner and Applicant's representative, Raymond Garguilo, Applicant's representative elected to prosecute the invention of Species II, drawn to claims 1-12 and 16-17 for prosecution in the present application. Claims 13-15 are hereby cancelled, as well as claim 2.

The Examiner has objected to the specification due to inclusion of character reference "5120" used to designate both a "prong" and "leg" in paragraphs [0048] and [0049], respectfully. With all due respect to the Examiner, the paragraph numbers the Examiner is actually referring to is [0049] and [0050] as included in the printed publication 2005/0143747. As such, Applicants have amended character reference 5120 to recite character reference 5210 for the term "leg" in paragraph 50. Applicants apologize for the inadvertent error.

CLAIM REJECTION - 35 U.S.C. § 102 - *Marnay*

Claims 1-3, 5, 9, 11 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 91/13598 to *Marnay*. In response to this rejection, Applicants have amended independent claims 1 and 16. Newly amended claims 1 and 16 now include the additional recitations that a second longitudinal axis passing between the center of the two protrusions or tines

of the fork-shaped extension is offset from a longitudinal axis passing through a center of an actuation handle on a plying device or instrument. This recitation was previously included within claim 2 of the present application, which has since been cancelled. However, in combining independent claim 1 with the now cancelled claim 2, Applicants have further clarified the recitation such that the present invention is clearly understood. No new matter has been added to the application for the result of this amendment. Similarly, claim 3 has been amended to more clearly recite the claimed invention.

In contrast to the newly amended independent claims 1 and 16, *Marnay* discloses an instrument that has an actuation handle with a longitudinal axis extending the length of the handle. However, this longitudinal axis also extends through a center point between two protrusions 812, 813, which extend outwardly from the actuation handles. This is clearly shown in FIG. 3 of *Marnay* where a center line is illustrated dissecting the actuation handle in half as well as the center point of the two protrusions. Therefore, *Marnay* does not solve one of the problems the present invention is designed for, which is not to obstruct a line of sight as a vertebral disc is being inserted. (Zubok, ¶ [0057]. Applicants thus assert newly amended 1 and 16 as well as their dependent claims are patentably distinct over *Marnay* and should be allowed.

CLAIM REJECTION - 35 U.S.C. § 102(b) - *Keller*

Claims 1-3, 5, 8-11 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent DE 3023942 to *Keller*. Similar to *Marnay*, *Keller* discloses an instrument that has prongs that are aligned and symmetrical with an actuation

handle. The prongs 19, 21 are centered relative to the actuation handles and thus a longitudinal axis passing through the center of the longitudinal handles also pass through at center point positioned between the prongs. Therefore, for arguments similar to *Marnay*, Applicants assert that independent claims 1 and 16 as well as their dependent claims are patentably distinct over *Keller*.

CLAIM REJECTION - 35 U.S.C. § 102(b) *Nuemann*

Claims 1-3, 5-10 and 16 are rejection under 35 U.S.C. § 102(b) as being anticipated by EP 1219266 to *Neumann*. The device in *Neumann* is similarly constructed to the device in *Marnay* and *Keller* in that prongs that extend outwardly from a handle are symmetrical relative to the handle. Therefore, a longitudinal axis passing through the center of a handle of the device in *Neumann* also passes through a center point that is positioned between the various prongs of *Neumann*. Additionally, neither *Neumann*, *Keller* nor *Marnay* disclose a distraction tool but rather all disclose an implementation tool that is not used to distract vertebral bodies. Applicants thus assert independent claims 1 and 16 as well as their dependent claims are patentably distinct over *Neumann* and should be allowed.

CLAIM REJECTION - 35 U.S.C. § 103(a) - *Marnay*

Claims 4 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Marnay*. The Examiner claims that *Marnay* fails to disclose one of the tines being aligned longitudinally with the elongated section of the instrument. But the Examiner argues that *Marnay* does disclose a centrally located dome within the plates and teeth on the exterior of the plates apart from

the dome. The Examiner believes it would have been an obvious matter of design choice to modify the location of the tines. The Examiner bases his opinion in that Applicant has not disclosed that using the tine that is longitudinally aligned with the elongated section of the fork-shaped extensions provides any advantage that solves a problem in the art. With all due respect to the Examiner, as discussed above with regards to claim 1, by aligning one of the tines with the elongated section of the instrument during insertion of a vertebral body, the viewing area of a surgeon remains unobstructed while the intervertebral device is being implanted and an intervertebral instrument is distracting adjacent intervertebral bodies. This is discussed in ¶ [0050] of the present application, which clearly illustrates this benefit. Further, this benefit is realized by having a longitudinal axis that passes through the center point positioned between two tines being offset from a longitudinal axis that passes through a center of the an instrument handle. Thus, Applicants assert that claims 4 and 17 are patentably distinct over *Marnay* and it would not have been an obvious matter of design choice to modify the location of the tines. The claims 4 and 16 should be deemed patentable not only for what they include individually but also based on the dependency from claim 1.

CLAIM REJECTION - 35 U.S.C. § 103(a) - *Marnay* and *Michelson*

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Marnay* in view of U.S. Patent No. 6,080,155 to *Michelson*. The Examiner admits that *Marnay* does not disclose that the extensions are attachable but argues that *Michelson* shows such a feature. As a result, the Examiner asserts that it would have been obvious to combine *Michelson* with *Marnay* to

render the claim 12 unpatentable. Claim 12 depends from claim 1 and thus discloses all of the recitation of claim 1. *Michelson* does not show an instrument having a handle that has a longitudinal axis as offset from a second longitudinal axis that passes between two tines. Applicants thus assert that claim 12 is patentably distinct over the cited are and should be allowed.

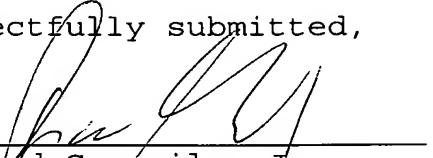
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefore.

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Respectfully submitted,

By 
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